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09/484,732	01/18/2000	Eric G. Suder	16312-P003D1	1037

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EXAMINER

CHOW, MING

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 08/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

541

## Office Action Summary

Application No.

09/484,732

Applicant(s)

SUDER ET AL.

Examiner

Ming Chow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 40-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 40-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “first caller ID modem” and “second caller ID modem” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “voice mail system” as claimed in claim 60 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

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The following is a quotation of the second paragraph of 35 U.S.C. 112: The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 40-60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "typical" on Line 15 Page 40 is not clearly defined. Although the "typical caller ID information" is described on line 8-10 page 19, however, the term "typical" is considered indefinite.

Regarding claims 55 and 57, the term "non-typical" is also indefinite. Claims 41, 42, 44-48, 50-54, 58-60, depend on the rejected claims.

4. Claim 52 recites the limitation "the step of ringing the analog telephone extension" in claim 51. There is insufficient antecedent basis for this limitation in the claim.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make

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and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 40, 49 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The phrase "circuitry for.....storing a message" of claims 40, 49 are not disclosed by the specification. The line 5-21 page 26 of the specification disclosed how the message is created for displaying without disclosing that the message is stored by a circuitry.

6. Claim 60 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase "the voice processing circuitry includes a voice mail system" of claim 60 is not disclosed by the specification. The line 15 page 22, line 21 page 22, line 3-21 page 26 disclosed voicemail message without disclosing that "the voice processing circuitry includes a voice mail system".

7. Claim 52 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase "the sending step includes the step of ringing the analog telephone extension" of claim 52 is not disclosed by the specification. The line 16-17 page 26 of the specifications disclosed step 1204 is

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the claimed “sending step”. The line 20-21 page 26 of the specification disclosed step 1206 is the claimed “ringing the analog telephone extension”. The step 1204 does not include the limitation described as the step 1206.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 40-44, 49-56, 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al (US: 5771283), and in view of Gordon (US: 6337898) and Chen (US: 5930346).

For claims 40, 49, 50, 55, 58, Chang et al teach on item 270 Fig. 2 circuitry coupling the system to an analog telephone extension.

Chang et al failed to teach “the analog telephone.....ID modem”. Gordon teaches on Fig. 3 an analog phone with a display and a caller ID modem (claimed “first caller ID modem”; item 35 Fig. 2).

Chang et al teach on Abstract – initiating the GID (reads on claimed “creating a message”) and the GID is stored in the module memory.

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Chang et al failed to teach “a second caller ID modem”. However, Chen teaches on item 303 Fig. 3 a caller ID generator (claimed “second caller ID modem”) within a central office switch.

Chang et al teach on column 5 line 10-11 origination switch retrieves GID information (reads on claimed “circuitry for retrieving the message from the storing circuitry to the second caller ID modem”).

Chang et al teach on item 270 Fig. 2 switch (claimed “circuitry”) for sending the message from the second caller ID to the first caller ID.

Chang et al failed to teach “circuitry for displaying the message on the display”. However, Gordon teaches on Fig. 3 a display circuitry.

Chang et al teach on Abstract – GID (reads on claimed “the message does not include typical caller ID information”).

It would have been obvious to one skilled at the time the invention was made to modify Chang et al to have the “the analog telephone.....ID modem” and “a second caller ID modem” and “circuitry for displaying the message on the display” as taught by Gordon and Chen such that the modified system of Chang et al would be able to support the analog telephone with a first caller ID modem, second caller ID modem, and a display to the system users.

Regarding claims 41, 51, Chang et al teach on Abstract – the GID is retrieved and sent in response to the caller makes a call to the telephone extension.

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Regarding claims 42, 52, Chang et al teach on column 6 line 12-17 the GID and caller's directory number are sent to the first caller ID modem while the phone is rung by the system.

Regarding claims 43, 53, 56, Chang et al teach on column 6 line 14 caller's directory number (claimed "typical caller ID information includes.....a phone number").

Chang et al failed to teach "typical caller ID information includes.....an identity of a calling party". However, Gordon teaches on column 5 line 31-33 calling line ID includes the calling name.

It would have been obvious to one skilled at the time the invention was made to modify Chang et al, Gordon, and Chen to have the "typical caller ID information includes.....an identity of a calling party" as taught by Gordon such that the modified system of Chang et al, Gordon, and Chen would be able to support the caller's name to the system users.

Regarding claims 44, 54, Chang et al teach on Fig. 2 circuitry for coupling the system to PSTN and circuitry for receiving the incoming call.

9. Claims 45, 46, 48, 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al, Gordon, and Chen as stated above in claim 42, and in view of Wilson et al (US: 5838772).

Regarding claim 45, Chang et al, Gordon, and Chen failed to teach "switching circuitry.....the system". However, Wilson et al teach on item 34 Fig. 1 switching circuitry, item 10 Fig. 1 voice processing circuitry and both are controlled by item 32 Fig. 1 call control



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processor (claimed “single processing means”). It would have been obvious to one skilled at the time the invention was made to modify Chang et al, Gordon, and Chen to have the “switching circuitry.....the system” as taught by Wilson et al such that the modified system of Chang et al, Gordon, and Chen would be able to support the switching circuitry, voice processing circuitry, and both are controlled by a single processing means to the system users.

Regarding claim 46, the modified system of Chang et al in view of Gordon, Chen, and Wilson et al as stated above in claim 45 failed to teach “the voice.....processing means”. However, Wilson et al teach on Fig. 1 DSP (claimed “signal processing circuitry”) coupled to the single processing means. It would have been obvious to one skilled at the time the invention was made to modify Chang et al, Gordon, Chen, and Wilson et al to have the “the voice.....processing means” as taught by Wilson et al such that the modified system of Chang et al, Gordon, Chen, and Wilson et al would be able to support the signal processing circuitry to the system users.

Regarding claim 48, the modified system of Chang et al in view of Gordon, Chen, and Wilson et al as stated above in claim 45 failed to teach “the single.....processing circuitry”. However, Wilson et al teach on column 2 line 41-43 software facilities. The complete software on the system is considered as a single set of software. It would have been obvious to one skilled at the time the invention was made to modify Chang et al, Gordon, Chen, and Wilson et al to have the “the single.....processing circuitry” as taught by Wilson et al such that the modified

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system of Chang et al, Gordon, Chen, and Wilson et al would be able to support the single set of software to the system users.

Regarding claim 60, the modified system of Chang et al in view of Gordon, Chen, and Wilson et al as stated above in claim 45 failed to teach “the voice.....mail system”. However, Gordon teaches on column 1 line 11 central office (reads on claimed “voice processing circuitry”) based voicemail. It would have been obvious to one skilled at the time the invention was made to modify Chang et al, Gordon, Chen, and Wilson et al to have the “the voice.....mail system” as taught by Wilson et al such that the modified system of Chang et al, Gordon, Chen, and Wilson et al would be able to support the voice mail system to the system users.

10. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al, Gordon, Chen, and Wilson et al as stated above in claim 46, and in view of McHale (US: 6088430). Chang et al, Gordon, Chen, and Wilson et al failed to teach “the switching circuitry further comprises a digital cross-point matrix”. However, McHale teaches on Fig. 4 a switch a cross-point matrix. It would have been obvious to one skilled at the time the invention was made to modify Chang et al, Gordon, Chen, and Wilson et al to have the “the switching circuitry further comprises a digital cross-point matrix” as taught by McHale such that the modified system of Chang et al, Gordon, Chen, and Wilson et al would be able to support the cross-point matrix to the system users.

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11. Claims 57, 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al, Gordon, and Chen as stated above in claim 55, and in view of Irie et al (US: 5862210).

Regarding claim 57, All rejections as stated in claim 55 above apply. Chang et al, Gordon, and Chen failed to teach “converting the.....back into the message”. However, Irie et al teach on column 1 line 39-45 converting the telephone number and the name (claimed “the message”) to tones, transmitting the tones, and converting the tones back to the message. It would have been obvious to one skilled at the time the invention was made to modify Chang et al, Gordon, Chen, to have the “converting the.....back into the message” as taught by Irie et al such that the modified system of Chang et al, Gordon, Chen, would be able to support the tone conversions to the system users.

Regarding claim 59, the rejections as stated in claim 51 and claim 52 above apply.

### ***Response to Arguments***

12. Applicant's arguments filed on 6/6/03 have been fully considered but they are not persuasive.

- i) Applicant argues, on page 6, regarding objections to the drawing. Applicant must show every feature specified in the claims.
- ii) Applicant argues, on page 7, regarding typical and non-typical caller ID information. Although the Applicant has described “typical ID” on line 8-10 page 19 of the specification, however, the word “typical” is still considered as indefinite. Applicant

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described the "typical caller ID" includes "ten-digit telephone number". As one skilled in the art knows different countries or regions have different number of digits as the telephone number. When a seven-digit telephone number is displayed as a caller ID, is it considered as a typical or non-typical caller ID data?

### *Conclusion*

13. The prior art made of record and not replied upon is considered pertinent to applicant's disclosure.

- Terschluse (US-PAT-NO: 6,118,857) teaches modem.

14. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:

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**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

**Or faxed to TC2600's Customer Service FAX Number 703-872-9314.**

Patent Examiner

Art Unit 2645

Ming Chow



FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

